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REMARKS

Applicants appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1-104 are pending in the subject application. Claims 77-104 are withdrawn from consideration as the result of an Examiner's earlier restriction requirement. Claims 74-76 are acknowledged as being allowable by the Examiner. Claims 32 and 77-104 are canceled. In view of the Examiner's earlier restriction requirement, Applicants reserve the right to present the above-identified withdrawn claims (claims 77-104) in a divisional application.

Claims 1-55, 59-63, 66, 68, 72 and 73 stand rejected under 35 U.S.C. §102, 35 U.S.C. §103, and/or 35 U.S.C. §112, second paragraph. Claims 56-58, 64, 65, 67 and 69-71 were objected to as depending from a rejected base claim; however, the Examiner indicated that the claims would be allowable if appropriately re-written in independent form.

Claims 32 and 77-104 were canceled in the instant amendment without prejudice to prosecuting them in a continuing application.

Claims 56 and 64 were re-written in independent form as suggested by the Examiner. Applicants reserve the right to later amend any one or more of claims 57-58, 65, 67 and 69-71 so as to be in independent form.

Claims 1, 22, 33, 38, and 43 were amended to more distinctly claim Applicants' invention and more particularly that the heat transferring device of the present invention is thermally coupled to a bearing, which is generating the un-useable heat energy.

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Claims 3, 4, 22, 23, 33, 34, 50 and 51 were amended to address the Examiner's non-art based rejections.

Claims 2-6, 8-9, 14-16, 18, 23, 25, 34, 38-40, and 42-47 were amended to reflect changes in the language of the base claim.

The amendments to the claims are supported by the originally filed disclosure.

35 U.S.C. §112, SECOND PARAGRAPH REJECTIONS

Claims 3, 4, 22, 23, 33, 34, 50 and 51 stand rejected under 35 U.S.C. §112 on the grounds that there are antecedent basis, indefiniteness and/or vagueness concerns with the identified claims.

As provided above the above-identified claims were amended to address the non-art concerns specifically identified by the Examiner. In this regard, Applicants would note that the intent was not only to indicate that the majority of the heat energy being produced by a bearing and communicated to the heat transferring device was being communicated to the portion in contact with the heat sink, but also to indicate that the flexible thermally conductive member was configured so it was capable of transferring the majority of the heat being generated by the bearing to the heat sink via the heat transferring device. As such, Applicants amended the claims to make more clear the later of the intended recitations. In this regard, Applicants would note that what is being claimed is the configuration and arrangement of the flexible thermal conductive member and thus this clearly relates to the amount of contact being made with the bearing as well as the capabilities to transfer heat energy.

Applicants believe that the areas of rejection have been identified and addressed in the

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foregoing amendment.

Accordingly, it is respectfully submitted that claims 3, 4, 22, 23, 33, 34, 50 and 51 satisfy the requirements of 35 U.S.C. §112 and, as such, are in a condition for allowance.

35 U.S.C. §102 REJECTIONS

Claims 1-49, 52-55, 59-63, 66, 68, 72, and 73 stand rejected under 35 U.S.C. §102 (b,e) as being anticipated for the reasons provided on pages 3-7 of the above-referenced Office Action. Specifically, claims 1-42 stand rejected under 35 U.S.C. §102(b) as being anticipated by Goldberg et al. [USP 5,317,879; “Goldberg”], claims 43-47 stand rejected under 35 U.S.C. §102(e) as being anticipated by Bonneville et al. [USP 6,367,509; “Bonneville”] and claims 48-49, 52-55, 59-63, 66, 68, 72 and 73 stand rejected under 35 U.S.C. §102(b) as being anticipated by Richter [DT 2624959]. Because claims were amended in the foregoing amendment, the following discussion refers to the language of the amended claim(s). However, only those amended features specifically relied on in the following discussion shall be considered as being made to overcome the prior art reference.

In foregoing amendments, each of the claims excluding claims 48-49, 52-55, 59-63, 66, 68, 72 and 73, were amended so the claimed invention relates to a heat generating device that is thermally coupled to a bearing. Thus, Applicants believe that each of these amended claims is distinguishable from either of Goldberg and Bonneville.

As to Richter, it is asserted that this reference discloses a heat conducting device for a bearing of a shaft and a flexible bellows section disposed between the bearing mount and a

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cylindrical portion contacting a heat sink. Applicants respectfully disagree with the characterization of what is disclosed in Richter.

The combination of the features in Richter does not yield an arrangement that is flexible, but rather is stiff because the arrangement is providing the pre-load for the beatings. As a significant force must be applied, it necessarily follows that the arrangement disclosed in Richter cannot be flexible as it would not be possible for the force to be applied. Therefore, Richter thus does not disclose, for example, the heat transferring device of claim 1, more particularly Richter does not disclose the flexible thermally conductive member of such a device.

As provided in MPEP-2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Or stated another way, "The identical invention must be shown in as complete detail as is contained in the ... claims. *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ 2d. 1913, 1920 (Fed. Cir. 1989). Although identify of terminology is not required, the elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). It is clear from the foregoing remarks that the above identified claims are not anticipated by the respectively cited reference.

It is respectfully submitted that for the foregoing reasons, claims 1-49, 52-55, 59-63, 66, 68, 72, and 73 are patentable over the cited reference and, therefore satisfies the requirements of 35 U.S.C. §102(b,e). As such, these claims, including the claims dependent therefrom are allowable.

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35 U.S.C. §103 REJECTIONS

Claims 3-4, 22-23, 33-34 and 50-51 stand rejected under 35 U.S.C. §103 as being unpatentable over the cited prior art for the reasons provided on pages 3-7 of the above-referenced Office Action. Specifically, claims 3-4, 22-23 and 33-34 stand rejected as being unpatentable over Goldberg and claims 50-51 stand rejected as being unpatentable over Richter. Because claims were amended in the foregoing amendment, the following discussion refers to the language of the amended claim(s). However, only those amended features specifically relied on in the following discussion shall be considered as being made to overcome the prior art reference. The following addresses the specific rejections provided in the above-referenced Office Action.

In foregoing amendments each of the claims excluding claims 48-49, 52-55, 59-63, 66, 68, 72 and 73, were amended so the claimed invention relates to a heat generating device that is thermally coupled to a bearing. Thus, Applicants believe that each of these amended claims is thus distinguishable from Goldberg.

As indicated above, the combination of the features in Richter does not yield an arrangement that is flexible, but rather is stiff because the arrangement is providing the pre-load for the beatings. As a significant force must be applied, it necessarily follows that the arrangement disclosed in Richter cannot be flexible as it would not be possible for the force to be applied. Therefore, Richter thus does not disclose, teach nor suggest for example, the heat transferring device of claim 1, more particularly Richter does not disclose, teach nor suggest the flexible thermally conductive member of such a device. Further, there is no teaching, suggestion of

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motivation offered in Richter to modify the device disclosed therein so as to yield the invention claimed by Applicants.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As provided above, the references cited, alone or in combination, include no such teaching, suggestion or motivation. Furthermore, and as provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 19866).

It is respectfully submitted that for the foregoing reasons, claims 3-4, 22-23, 33-34 and 50-51 are patentable over the cited reference(s) and thus, satisfy the requirements of 35 U.S.C. §103. As such, these claims, including the claims dependent therefrom are allowable.

CLAIMS 56-58, 64-65, 67 & 69-71

In the above-referenced Office Action, claims 56-58, 64-65, 67 and 69-71 were objected to as being dependent upon a rejected base claim. It also was provided in the above-referenced Office Action, however, that these claims would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim(s).

Claims 56 and 64 were re-written in the foregoing amendment so as to be in independent

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form and to include all the limitations of the base claim there being no intervening claims.

Accordingly, claims 56 and 64 are considered to be in allowable form.

As Applicants believe that the related base claims are in allowable form; claims 57-58, 65, 67 and 69-71 were not re-written in independent form as suggested by the Examiner. Applicants, however, reserve the right to later amend the subject application so as to present any one or more of these claims in independent form or to add one or more independent claims that contain the limitations of any one or more of claims 57-58, 65, 67 and 69-71.

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Applicants believe that additional fees are not required for consideration of the within Response. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,
Edwards & Angell, LLP

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By:


William J. Daley, Jr.
(Reg. No. 35,487)
P.O. Box 55874
Boston, MA 02205
(617) 439-4444

Customer No. 21,874

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